<u>REMARKS</u>

Claims 1-11 and 13-30 are currently pending in the subject application and are presently under consideration.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I.   **Rejection of Claims 1, 8-10 and 28 Under 35 U.S.C. §102(e)**

Claims 1, 8-10 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Bibelnieks *et al.* (U.S. 2003/0208402). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Bibelnieks *et al.* does not teach or suggest each and every limitation of applicants' claimed invention.

> A single prior art reference anticipates a patent claim only if it expressly or inherently describes **each and every limitation** set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.,* 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). **The identical invention must be shown in as complete detail as is contained in the ... claim.** *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added).

The subject invention relates to methods and systems for identifying a sub-population of a population to solicit and a sub-population of the population not to solicit that will maximize profits for an advertiser performing solicitation. For instance, applicants' claimed invention can take a sample of a population of potential purchasers, divide the sample into a solicitation group and a non-solicitation group, and solicit the solicitation group. Tracking of purchases and non-purchases by members of each group allows for a model to be constructed that can be used against the entire population to identify a sub-population to solicit and a sub-population not to solicit that will maximize profits. Applicants' claimed invention minimizes solicitation of members who will not make a purchase, who are already planning on buying, and/or who planned on buying but will not buy if solicited, thereby reducing cost of solicitation. The method also increases solicitation to a subset of members who will buy if solicited, thereby maximizing purchases. In particular, as recited in independent claims 1 and 28, applicants' claimed invention

sets a purchase variable to a first value for each of the plurality of members of the solicitation and *the non-solicitation sub-population that made a purchase and to a second value for each of the plurality of members* of the solicitation and *the non-solicitation sub-populations that did not make the purchase*.

Bibelnieks *et al.* does not teach or suggest the aforementioned novel aspects of applicants' claimed invention. Rather, Bibelnieks *et al.* discloses a system that factors in the impact of multiple promotions to one or more classes of customers over a specified time. The cited reference attempts to improve direct marketing by determining the cannibalization impact one promotion has on another promotion for a given customer or customer class during this time. The system only tracks purchase information for customers who were sent solicitations. The system is silent regarding setting a purchase variable for non-solicited members of a sub population. Applicants' claimed invention tracks solicitation and purchase information for solicited and non-solicited members of a subpopulation, so that this information can be applied to the larger population in making solicitation decisions. Therefore, Bibelnieks *et al.* does not teach or suggest setting a purchase variable to a first value for each of the plurality of members of the solicitation and the non-solicitation sub-population that made a purchase and to a second value for each of the plurality of members of the solicitation and the non-solicitation sub-populations that did not make the purchase as in applicants' claimed invention.

In view of at least the foregoing, applicants' representative respectfully submits that Bibelnieks *et al.* fails to teach or suggest all limitations of applicants' invention as recited in independent claims 1 and 28 (and claims 8-10 that depends there from), and thus fails to anticipate the claimed invention. Therefore, this rejection should be withdrawn.

II.   Rejection of Claims 2-7, 11, 13-27, 29, 30 Under 35 U.S.C. §103(a)

Claims 2-7, 11, 13-27, 29, 30 are rejected under 35 U.S.C. 103(a) as unpatentable over Bibelnieks *et al.* (U.S. 2003/0208402) as applied to claim 1 above, and further in view of Kohavi (U.S. 6,182,058). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Bibelnieks *et al.* in view of Kohavi does not teach or suggest each and every limitation of applicants' claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claims 11 and 24 (similarly to independent claims 1 and 28) recite *setting the purchase variable to the first value for each of the plurality of members of the solicitation and the non-solicitation groups that made a purchase and to the second value for each of the plurality of members of the solicitation and the non-solicitation groups that did not make the purchase;... applying the decision tree against the population to identify the sub-population to solicit.* As discussed *supra* with respect to independent claims 1 and 28, Bibelnieks *et al.*fails to teach or suggest these novel features of the subject claims. Furthermore, Kohavi fails to make up for the deficiencies of Bibelnieks *et al.* with respect to these claimed features. Rather, Kohavi discloses a hybrid classifier, called the NB-Tree classifier, for classifying a set of records. In an example, Kohavi teaches a marketing campaign where responses are tracked to determine who is likely to respond. However, Kohavi fails to teach a solicitation variable that is set to the first value for each of a plurality of members of the solicitation group and to the second value for each of a plurality of members of the non-solicitation group. Kohavi does not indicate that unsolicited members are tracked and therefore would not need to set a solicitation variable. Furthermore, Kohavi also fails to teach a purchase variable that is set with a first value for purchase and a second value for non-purchase. A likeliness to respond is not analogous to a purchase. A recipient of the marketing campaign may respond, such as to request more information or look at a product, without ever making a purchase. Moreover, Kohavi fails to mention purchase or buy anywhere in the patent.

Therefore, Bibelnieks *et al.* and Kohavi do not teach or suggest setting the purchase variable to the first value for each of the plurality of members of the solicitation and the non-solicitation groups that made a purchase and to the second value for each of the plurality of members of the solicitation and the non-solicitation groups that did not make the purchase;…and applying the decision tree against the population to identify the sub-population to solicit to maximize the expected increase in profits as in applicants' claimed invention.

Claims 2-7 and 29-30 depend from independent claims 1 and 28 respectively. As discussed above with respect to independent claims 11 and 24, Kohavi fails to cure the above noted deficiencies of Bibelnieks *et al.* regarding independent claims 1 and 28.

In view of at least the above, it is respectfully submitted that Bibelnieks *et al.* and Kohavi, alone or in combination, fail to teach or suggest all aspects of applicants' invention as recited in independent claims 1, 11, 24, and 29 (and claims 2-7, 13-23, and 25-27 that depend there from), and thus fails to make obvious the subject claimed invention. Accordingly, this rejection should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP282US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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